

## **REMARKS**

Claims 17-22 are pending after entry of the present amendment. Claim 17 is hereby amended and Claims 21-22 are newly presented. Support for amended and new claims may be found throughout the Specification and the original claims, for example, the Specification at pages 8-12.

Applicants thank the Examiner for withdrawing the previously applied rejection under 35 U.S.C. § 103(a) over JP 05-139921 (“Suzuki *et al.*”) in view of WO 01/26468 (“Senn *et al.*”).

### **I. Rejection under 35 U.S.C. § 103(a)**

Claims 17-20 stand rejected as being allegedly unpatentable over U.S. Patent No. 5,876,739 (“Turnblad *et al.*”) in view of WO 01/26468 (“Senn *et al.*”) and U.S. Patent No. 4,523,947 (“Szczepanski *et al.*”). This rejection is respectfully traversed for at least the following reasons.

The Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), factors control an obviousness inquiry. Those factors are: 1) “the scope and content of the prior art”; 2) the “differences between the prior art and the claims”; 3) “the level of ordinary skill in the pertinent art”; and 4) objective evidence of nonobviousness. *KSR*, 127 S. Ct. at 1734 (quoting *Graham*, 383 U.S. at 17-18). While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the Court acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *KSR*, 127 S. Ct. at 1731. Moreover, the Court indicated that there is “no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis.” *Id.* As long as the test is not applied as a “rigid and mandatory” formula, that test can provide “helpful insight” to an obviousness inquiry. *Id.* In this regard, “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 127 S.Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Applicants disagree with the Examiner's basis for the obviousness rejection under 35 U.S.C. § 103(a). In rejecting the claims, the Examiner acknowledges that Turnblad *et al.* fails to disclose or suggest all of the claim elements. Office Action at page 3. Specifically, the Examiner acknowledges that Turnblad *et al.* does not provide a specific teaching of applying an insecticide composition to maize or corn seed together with applying an herbicide composition to maize or corn. *Id.* In accounting for this deficiency, the Examiner asserts that Senn *et al.* provides motivation for applying both insecticidal and herbicidal compositions to maize seeds. *Id.* at page 4. The Examiner further asserts that Szczepanski *et al.* provides motivation to use "triazines for protecting maize plants against the harmful effects of chloroacetamides and the administration of two herbicides together." *Id.* Applicants respectfully disagree with the Examiner's rejection.

At the outset, Turnblad *et al.* fails to teach or suggest a method of reducing phytotoxicity in general, let alone a method of reducing phytotoxicity caused by herbicidal application to corn or maize. In addressing this aspect, the Examiner misconstrues Turnblad *et al.* and rejects the claims by asserting that "[t]he insecticidal coating on the seed is effective against insect pests without causing phytotoxicity to the seed (Col. 2, lines 45-50)." *Id.* at page 3. However, the Examiner's reliance on Turnblad *et al.* to reject the claims is incorrect. Turnblad *et al.* does not even mention reducing phytotoxicity caused by the application of an herbicide to maize or corn. At best, Turnblad *et al.* generally indicates that the insecticidal coating does not cause phytotoxicity, which can be distinguished from the claimed method of reducing phytotoxicity caused by herbicide application. Turnblad *et al.* at column 2, lines 49-50 (emphasis added).

Moreover, as admitted by the Examiner, Turnblad *et al.* fails to teach or suggest a method of reducing phytotoxicity by applying a specific combination of compounds, a chloronicotinyl insecticide together with an herbicide, to corn or maize. Office Action at page 3. Turnblad *et al.* does not even specifically teach or suggest the claimed combination of chloronicotinyl insecticides together with an herbicide selected from chloroacetamides, imidazolinones, oxyacetamides, sulfonylureas, triazines, triketones, and isoxazoles. At best, Turnblad *et al.* describes a lengthy list of potential insecticides and herbicides, but provides no motivation such that one of ordinary skill in the art would select the specific chloronicotinyl insecticide and herbicide combinations as set forth in Claim 17.

Senn *et al.* does not remedy the deficiencies of Turnblad *et al.* and fails to provide any

specific motivation whatsoever to reduce phytotoxicity caused by herbicides by applying a chloronicotinyl insecticide compound together with an herbicidal compound to corn or maize. In fact, the methods set forth in Senn *et al.* bear no relationship whatsoever to a method of reducing phytotoxicity caused by an herbicide application. For one, Senn *et al.* do not teach the application of an insecticide together with an herbicide to corn or maize, let alone the specific combination of compounds set forth in Claim 17. Rather, Senn *et al.* generally describe applying neonicotinoid compounds to plants in order to improve plant growth. Senn *et al.* at page 2, lines 13-16 and page 4, lines 3-4. However, this is not enough to render the claims obvious under 35 U.S.C. § 103(a).

Szczepanski *et al.* fails to remedy the deficiencies of both Turnblad *et al.* and Senn *et al.* For one, Szczepanski *et al.* does not teach or suggest reducing phytotoxicity caused by herbicides by applying a chloronicotinyl insecticide compound together with an herbicidal compound to corn or maize. Moreover, Szczepanski *et al.* does not provide any specific suggestion such that one of ordinary skill in the art would have the requisite motivation to alter the teachings of either Turnblad *et al.* or Senn *et al.* and attempt to reduce phytotoxicity in corn or maize by utilizing the specific claimed chloronicotinyl insecticide/herbicide combinations. Rather, at best, Szczepanski *et al.* teaches protecting plants by using triazine derivatives, but fails to teach or suggest reducing phytotoxicity by applying a chloronicotinyl insecticide compound together with an herbicidal compound to corn or maize as set forth in the claims.

Applicants disagree with the Examiner's justification for combining Turnblad *et al.*, Szczepanski *et al.*, and Senn *et al.* and rejecting the claims under 35 U.S.C. § 103(a). Specifically, in rejecting the claims, the Examiner asserts that "[o]ne would be motivated to use the insecticide and herbicide of the present invention because it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose." Office Action at page 4. However, Applicants respectfully submit that this analysis misses the point and incorrectly dismisses the language "reducing phytotoxicity to corn or maize caused by herbicide application" of Claim 17. That is, the Examiner appears to treat Claim 17 as a composition claim in asserting that "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose." *Id.* Such a conclusion by the

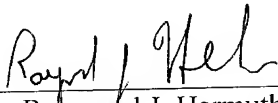
Examiner is both legally and factually incorrect.

Accordingly, Claims 17-20 are not properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Turnblad *et al.* in view of Senn *et al.* and Szczepanski *et al.* Applicants respectfully request withdrawal of this rejection.

#### **Conclusion**

This application is believed to be in condition for allowance. If this application is believed to be deficient for any reason, Applicants request a personal interview with the Examiner in an effort to expedite prosecution of this application.

Respectfully submitted,

By   
Raymond J. Harmuth.  
Attorney for Applicants  
Reg. No. 33,896

Bayer CropScience LP  
2 T.W. Alexander Drive  
Research Triangle Park, NC 27709  
Ph: 919-549-2102  
Fax: 919-549-3994  
Q:patents/prosecution documents/cs7890/7890 amendment 12-17-09